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MEDICINELODGE INC.			WOO, JULIAN W	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/680,079
Filing Date: October 07, 2003
Appellant(s): CHAN, KWAN-HO

MAILED
DEC 07 2007
Group 3700

David Meibos
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 29, 2007 appealing from the Office action mailed March 14, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,330,488	Goldrath	07-1994
5,376,096	Foster	12-1994

5,681,333 Burkhart et al. 10-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 36 is rejected under 35 U.S.C. 102(b) as being anticipated by Violante (3,840,017). Violante discloses, at least in figures 1 and 2 and col. 2, lines 3-15; a surgical apparatus for delivering and retrieving suture (32), where the apparatus includes a cannula (20) having a distal end and a proximal end and a lumen extending therebetween; a handle(10) having a distal end and a proximal end, a passageway (22) extending through at least a portion of the handle, and an exposed, planar surface with a platform (28) disposed between the passageway and the distal end of the handle, where the proximal end of the cannula is attached to the handle and the lumen is in communication with the exposed surface of the handle, where the exposed surface is adapted to support a suture extending through the handle and allow movement of suture with a thumb or finger, where the passageway is provided with an opening (24) at the handle proximal end, where the opening is positioned to permit suture to be fed into the opening along a pathway parallel to the lumen (when the spool is removed for threading of the suture into the passageway), and where the distal end (42) of the cannula is configured to drive a suture against tissue without severing the suture.

Claims 31, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Violante (3,840,017) in view of Burkhart et al. (5,681,333). Violante discloses the invention substantially as claimed. Violante discloses a surgical apparatus including a passer assembly with a handle and a cannula with a lumen, the

handle including a passageway in an elongated body, a recess in the body defining a planar surface, and a nose portion extending distally of the recess and defining a bore in communication with the passageway, the planar surface, and the lumen. However, Violante does not disclose a puller assembly or loop retriever including a suture engager movable through the nose portion bore, through the cannula lumen, and distally to connect to a suture and proximally to withdraw the suture engager and the connected suture. Burkhart et al. teach, in figures 6-9, a surgical apparatus for delivering and retrieving suture, where the apparatus includes a passer assembly (50) and a puller assembly (66) or loop retriever (70), where the passer assembly includes a handle (54) and a cannula (60), where the handle comprises an elongated body having a passageway extending distally from a suture entryway (62) axially disposed at a proximal end of the body, a recess (56) in the body defining a planar surface extending along an axis of the passageway, and a nose portion (distal end of 54) extending distally of the recess, where the puller assembly or loop retriever (70) is movable through the passageway, the nose portion, and cannula of the passer assembly. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Burkhart et al., to include a puller assembly as claimed with the apparatus of Violante. Such an assembly would allow the advancement (and retrieval) of suture and suture loops (without breakage) in the small confines of Violante's passer assembly and surgical spaces as in a subacromial space.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Violante (3,840,017) in view of Burkhart et al. (5,681,333), and further in view of Goldrath

(5,330,488). Violante in view of Burkhart et al. discloses the invention substantially as claimed, but does not disclose a puller assembly that is a hook retriever. Goldrath teaches, in col. 5, lines 42-48, a puller assembly that can be a loop retriever or a hook retriever, among other configurations. Thus, it would have been a matter of obvious design choice to configure the puller assembly of Violante in view of Burkhart et al. as a loop retriever or a hook retriever. The choice would be dependent upon a user's desired performance features for a retriever, and most important, whether the retriever is able to capture suture in a mode as desired by the user. Moreover, a hook would conveniently allow the grasping of a suture from the side the suture, rather than having to thread the suture through a loop.

(10) Response to Argument

The allegation on pages 5 and 6, paragraph VII (A), of the brief that Violante does not disclose a suture passer as claimed in claim 36 is incorrect. Violante indeed discloses a cannula comprising at least a portion of the distal end of the cannula being configured to drive a suture against tissue without severing the suture. That is, although Violante discloses a cannula with a "beveled and sharpened tip," as the Applicant has described the distal end; at least a portion of the tip can be deemed to be blunt or to possess a blunt heel. Firstly, the face of the bevel itself is blunt and can be applied to drive a suture without severing the suture. Also, although the "trailing end of the bevel" is "sharply acute," as the Applicant has described the tip of Violante's cannula; the leading end of the bevel forms a blunt, obtuse angle or heel with the side surface of the cannula. Moreover, the "sharply acute" portion of the "beveled shape" of the tip forms a

narrow point that would not likely engage and sever a suture. The point of the cannula tip in Violante's device is configured for tissue penetration. Thus, there is little or no danger that a suture inserted through the use of the device of Violante would be severed during insertion.

The allegation on pages 7-10, paragraph VII (B), of the brief that it is not clear that Violante can be combined with Burkhart et al. is incorrect. First of all, in response to the Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. There is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as whole would suggest to one of ordinary skill in the art. Moreover, in response to the Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. In short, the Examiner indeed considered the disclosures of the prior art and knowledge gleaned from the prior art in order to arrive at a reconstruction of the invention with a rational underpinning for supporting the obviousness conclusion and without citing the benefit of the Applicant's inventive work.

That is, Violante and Burkhart et al. both disclose or teach passer assemblies (32 and 50, respectively) possessing similar structures and which are of the same, analogous, suturing art. Burkhart et al. further teach a puller assembly or a loop retriever (70) that is used with the passer assembly (50). Burkhart et al. teach that the puller assembly (70) is usable for the advancement of a suture through a cannula in the passer assembly of Burkhart et al. without breakage of the suture while it is inserted into a small surgical space. Thus, one of ordinary skill in the art would be motivated to modify the device of Violante to include a puller assembly as taught by Burkhart et al. The teaching of a passer assembly used with a suture and a passer assembly provides a rational underpinning for combining Burkhart et al. with Violante. Moreover, modifying the sizes of the devices of Violante and Burkhart et al. in order to arrive at the inventive apparatus would not require hindsight reasoning. Size modifications would have involved mere changes in the size of components. Changes in size are generally recognized to be within the level of ordinary skill in the art.

Finally, the allegation on pages 10-11, paragraph VII (C), of the brief that that there is no suggestion to combine the references of Violante, Burkhart et al., and Goldrath is incorrect. The Examiner recognizes that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. There is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as whole would suggest to one of ordinary skill in the art. That is, Violante, Burkhart et al., and Goldrath disclose or teach the passage of

sutures through cannulas, and which are references from the same, analogous suturing art. Specifically, Goldrath indeed enables the use of a hook retriever with a cannula, while teaching other configurations of suture retrievers also usable with a cannula. Thus, Goldrath teaches that a user may have a choice among configurations of suture retrievers. The choice of a hook retriever, rather than a loop retriever, would be dependent upon the user's desired performance characteristics for a retriever. In other words, it is within the general skill of user in the art to select a retriever on the basis of its suitability for the intended use as a matter of obvious design choice.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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